UNITED STATES PATENT AND TRADEMARK OFFICE

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09/963,914	09/26/2001	Timothy E. Wood	13768.203	9417

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WORKMAN NYDEGGER/MICROSOFT
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER
HUYNH, THU V

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the c ver sheet with the correspondence address* --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/26/2001*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: IDS and application filed on 09/26/2001.

2.   Claims 1-22 are pending in the case. Claims 1, 10-11, 16, and 21 are independent claims.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   **Claims 8-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 8 and 12, which are dependent claims 1 and 11 respectively. The phrase "the content that might by displayed in response to events that might occur" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed, thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 9, which is dependent claim 1. Claim 9 recites the limitation "wherein *the specific act of retrieving one or more data structure* ". There is insufficient antecedent basis for this limitation in the claim.

Examiner assumes that claim 9 dependent on claim 8 for examination purpose.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 1-3, 6, 8, 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by**

<u>Gao</u> et al., US 2002/0032701 A1, priority filed 09/2000.

Regarding independent claim 1, Gao teaches the steps of:

- a specific act of retrieving the document from the server computer system (Gao, page

   3, paragraph 32; page 4, paragraph 46; retrieving the requested HTML document

   from a server to a client);

- a specific act of detecting a reference in the document to computer-executable

   instructions not included in the document (Gao, page 4, paragraph 46; detecting a

   script tag in the HTML document that references to a Script source);

- a specific act of retrieving the computer-executable instructions (Gao, page 5,

   paragraph 48; retrieving the Script program from the server);

- a specific act of detecting an event (Gao, page 3, paragraph 34; detecting a pointer or

   mouse over an element);

- a specific act of executing the , computer-executable instructions to thereby

   implement the following:

- a specific act of retrieving content in response to the event (Gao, page 5,

  paragraph 49; Script code cause request a second content);

- a specific act of overlaying the content over the displayable form of the

  document after retrieving the content (Gao, page 3, paragraph 34; page 5;

  paragraph 50; overlaying the popup window with content over the HTML

  document).

Regarding dependent claim 2, which is dependent on claim 1, Gao teaches the specific

act of retrieving document from the server computer system comprises the following:

a specific act of retrieving a HyperText Markup Language (HTML) document from

the server computer system (Gao, page 3, paragraph 32; page 4, paragraph 46).

Regarding dependent claim 3, which is dependent on claim 2. Gao teaches wherein the

specific act of detecting a reference in the document to computer-executable instructions not

included in the document comprises the following: a specific act of the detecting a SCRIPT tag

in the HTML document (Gao, page 4, paragraph 46).

Regarding dependent claim 6, which is dependent on claim 1, Gao teaches wherein the

specific act of detecting an event comprises the following: a specific act of detecting that a

pointer has moved to a certain region of the displayable form of the document (Gao, page 3,

paragraph 34).

Regarding dependent claim 8, which is dependent on claim 1, Gao teaches wherein the specific act of retrieving the computer-executable instructions comprises the following: a specific act of retrieving one or more data structure that represent at least some of the content that might be displayed in response to events that might occur while the displayable form of the document is being displayed (Gao, page 3, paragraph 34; page 5; paragraph 50).

Regarding independent claim 10, Gao teaches the steps of:

- a step for retrieving the document associated computer-executable instructions from the server computer system (Gao, page 3, paragraph 32; page 4, paragraph 46; retrieving the requested HTML document from a server to a client, wherein the HTML document references to Script file);

- a specific act of detecting an event (Gao, page 3, paragraph 34; detecting a pointer or mouse over an element);

- a step for executing the computer-executable instructions so as to overlay the content over the displayable form of the document in response to the event (Gao, page 3, paragraph 34; page 5; paragraph 50; overlaying the popup window with content over the HTML document).

Claims 11-13 are for a computer readable medium performing the method of claims 1 and 8, and are rejected under the same rationale.

Regarding dependent claim 14, which is dependent on claim 11, Gao teaches wherein the computer-readable medium is a physical storage media (Gao, page 3, paragraphs 38-39).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
owned at the time a later invention was made in order for the examiner to consider the applicability of 35
U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   **Claims 4, 9, 16-18, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Gao et al., as applied to claim 1 above and further in view of Hunt et al., US

2004/0133848 A1, provisional filed 04/2000.

Regarding dependent claim 4, which is dependent on claim 1. Gao teaches wherein the

specific act of retrieving the computer-executable instructions comprises the following: a

specific act of retrieving computer-executable instructions that operate the overly a window over

the displayable form of the document (Gao, page 3, paragraph 34; page 5; paragraph 50).

However Gao does not explicitly disclose overlaying a window over the document *even if*

other windows or frames already overly the displayable form of the document.

Hunt teaches, "a popup window may be closed automatically or it may require the user to

explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Regarding dependent claim 9, which is dependent on claim 1, Gao does not explicitly teaches wherein the specific act of retrieving one or more data structure comprises the following: retrieving one or more data structures that are structured in accordance with the eXtensible Markup Language (XML) format.

Hunt teaches method for providing and displaying information (Hunt's title), using Script to provide popup information for the user in HTML or XML content (Hunt, page 6, paragraph 86; page14, paragraph 177; page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt's XML content into Gao to provide data in XML format, since the combination would have provided both XML or HTML content to be displayed in popup windows for the user.

Regarding independent claim 16, Gao teaches the steps of:

- a specific act of displaying the displayable form of the document (Gao, page 3, paragraph 32; page 4, paragraph 46; retrieving the requested HTML document from a server to display at a client's computer);

- a specific act of receiving a user input designating the movement of a pointer to a certain region of the displayable form of the document (Gao, page 3, paragraph 34);

- a specific act of retrieving content associated with certain region in response to receiving the user input designating the movement of a pointer to the certain region of the displayable form of the document (Gao, page 3, paragraph 34; page 5, paragraph 49; script code cause request a second web page content for displaying when a mouse over an element in HTML document);

- a specific act of displaying the retrieved content in a second window over the displayable form of the document at least partly (Gao, page 3, paragraph 34; page 5; paragraph 50; overlaying the popup window with content over the HTML document).

Gao does not explicitly disclose displaying a first window over a portion of the document and displaying a second window over the document during the specific act of displaying the first window over the document.

Hunt teaches, "a popup window may be closed automatically or it may require the user to explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Regarding dependent claim 17, which is dependent on claim 16, Gao teaches wherein the specific act of receiving a user input designating the movement of a point to a certain region of the displayable form of the document comprises the following: a specific act of detecting a pointing device cursor within the certain region (Gao, page 3, paragraph 34).

Regarding dependent claim 18, which is dependent on claim 16, Gao teaches wherein the specific act of receiving a user input designating the movement of a point to a certain region of the displayable form of the document comprises the following: a specific act of detecting the movement using an OnMouseOver handler (Gao, page 3, paragraph 34).

Claim 21 is for a computer readable medium performing the method of claim 16, and is rejected under the same rationale.

Regarding dependent claim 22, which is dependent on claim 21, Gao teaches wherein the computer-readable medium is a physical storage media (Gao, page 3, paragraphs 38-39).

9.   **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gao as applied to claim 1 above and further in view of Holbrook et al., US 2002/0152222 A1, provisional filed 11/2000.**

Regarding dependent claim 7, which is dependent on claim 6. Gao does not explicitly disclose wherein the specific act of retrieving content in response to the event comprises the

following: a specific act of retrieving *update information* related to the area of the displayable

form of the document over which the pointer has moved (Gao, page 3, paragraph 34; page 5;

paragraph 50). Gao does not explicitly disclose retrieving *help information*.

Holbrook teaches help or any desired information are displayed in a popup window in

response to a mouse over an element of a web page to help the user understands more about the

element (Holbrook, page 6, paragraph 79).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Holbrook and Gao to provide help, update or desired

information that related to the elements in the web page, since the combination would have

provides more information about the elements on primary web pages without cluttering such web

pages.

10.   **Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gao as**

applied to claim 1 above and further in view of Hunt et al., US 2004/0133848 A1,

provisional filed 04/2000, and Holbrook et al., US 2002/0152222 A1, provisional filed

11/2000.

Regarding independent claim 15, Gao teaches the steps of:

-      a specific act of retrieving an HTML document from the server computer system

        (Gao, page 3, paragraph 32; page 4, paragraph 46; retrieving the requested HTML

        document from a server to a client);

- a specific act of detecting a script tag in the HTML document (Gao, page 4,

  paragraph 46; detecting a script tag in the HTML document that references to a Script

  source);

- a specific act of retrieving the computer-executable instructions identified by the

  script tag, the computer-executable instruction for overlying a window over the

  displayable form of the document (Gao, page 5, paragraphs 48-50; retrieving the

  Script program from the server for overlaying a popup window with content over the

  HTML document);

- a specific act of detecting that a pointer has moved to a certain region of the

  displayable form of the document (Gao, page 3, paragraph 34; detecting a pointer or

  mouse over an element in the HTML document);

- a specific act of executing the computer-executable instructions to thereby implement

  the following:

  - a specific act of retrieving content in response to the event (Gao, page 5,

    paragraph 49; Script code cause request a second content);

  - a specific act of overlaying the content over the displayable form of the

    document after retrieving the content (Gao, page 3, paragraph 34; page 5;

    paragraph 50; overlaying the popup window with content over the HTML

    document).

Gao does not explicitly disclose overlaying a window over the document even if other

windows or frames already overly the displayable form of the document; and the content is

contextual help.

Hunt teaches, "a popup window may be closed automatically or it may require the user to explicitly close it" (Hunt, page 22, paragraph 343).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hunt popup window's modes into Gao to overlaying a window over the document during other windows already overly the displayable form of the document, since the combination would have provided options for display popup windows and the user controls (closes) what popup window as the user wants/needs.

Holbrook teaches help or any desired information are displayed in a popup window in response to a mouse over an element of a web page to help the user understands more about the element (Holbrook, page 6, paragraph 79).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Holbrook and Gao to provide help, update or desired information that related to the elements in the web page, since the combination would have provides more information about the elements on primary web pages without cluttering such web pages.

11.   **Claims 5, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gao in view of Hunt applied to claims 4 and 16 above and further in view of Yehuda Shiran, "Scriplet Authoring", http://www.webreference.com/js/tips/991222.html, published 12/1999, pages 1-2.**

Regarding dependent claim 5, which is dependent on claim 4. Gao teaches wherein the specific act of retrieving computer-executable instructions that operate to overly a window

comprises the following: a specific act of using the computer-executable instructions to generate

a script (Gao, page 5, paragraph 48; generating appropriate JavaScript).

Gao does not explicitly disclose the script is a scriptlet.

Shiran teaches, "scriptlet is an independent script that is reference from an HTML page to

describe the behavior of an object and the event it is triggered by" as Shiran disclosed in page 1,

first paragraph.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Shiran's scriptlet into Gao, since the combination would

have provided many kind of scripts to provide popup windows when an event is triggered.

Regarding dependent claim 19, which is dependent on claim 16, Gao teaches wherein

the specific act of retrieving content associated with the certain region in response to receiving

the user input designating the movement is implemented by a script (Gao, page 5, paragraph 48).

Gao does not explicitly disclose the script is a scriptlet.

Shiran teaches, "scriptlet is an independent script that is reference from an HTML page to

describe the behavior of an object and the event it is triggered by" as Shiran disclosed in page 1,

first paragraph.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Shiran's scriptlet into Gao, since the combination would

have provided many kind of scripts to provide popup windows when an event is triggered.

Regarding dependent claim 20, which is dependent on claim 16, Gao teaches wherein the specific act of displaying the retrieved content in a second window over the displayable form of the document is implemented by a script (Gao, page 5, paragraph 48; generating appropriate JavaScript).

Gao does not explicitly disclose the script is a scriptlet.

Shiran teaches, "scriptlet is an independent script that is reference from an HTML page to describe the behavior of an object and the event it is triggered by" as Shiran disclosed in page 1, first paragraph.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Shiran's scriptlet into Gao, since the combination would have provided many kind of scripts to provide popup window when an event is triggered.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Feldman, US 6,297,822 B1, filed 1998, teaches help display for computer software programs.

Schwerdtfeger et al., US 6,725,424 B1, filed 1999, teaches JavaScript event used to trigger a change in displayed element when the cursor of pointer is passed over the displayed element using mouse.

Landsman et al., US 2003/0028565 A1, priority filed 1999, teaches external script is reference form an HTML page to display advertisement.

Lim, US 2003/0184583 A1, filed 07/2001, teaches scriptlet.

Pasquali, US 2002/0012010 A1, filed 042001, teaches method for facilitating a window based content manifestation environment within a www browser.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 273-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 273-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
December 22, 2004

STEPHEN HONG
SUPERVISORY PATENT EXAMINER